

Appl. No. 09/641,535
Reply dated May 31, 2006
Reply to Office Action mailed December 1, 2005
Attorney Docket No. 2101785-991100

REMARKS

Claims 1- 51 are pending. Claims 1-5, 7-12, 14-17, 19, 21-23, 25-27, 29-30, 32-36, 38-9, 41-7 and 49-51 are pending after this response. Reconsideration is respectfully requested.

CLAIM REJECTIONS

In response to the examiner's assertion that the phrase "without installing the rental program on the user computer system" is new matter, Applicant respectfully disagrees. In particular, the specification in the background discusses a typical system in which software programs are installed on a computer system (See page 1 line 20 – page 2, line 16). Then, the specification refers to "install free technology" at various places. The specification further recites "The 'rental software program' means a software application or program rented from a server computer system 16 to a user computer system 10 based on a user-transparent program install-free technology in accordance with the invention. In the preferred embodiment, the user transparent install-free technology is the downloading of the main software application file initially and then the automatic download of the other optional files as described below with reference to Figure 10" on page 6, lines 16-24 of the specification. Furthermore, the specification recites "At step S440, the user computer system downloads a main executable file and a list of optional files associated with the desirable rental software program from the server computer system. At this time, a process manager contained in the user computer system creates and runs a process corresponding to the main executable file" at page 12, lines 5-10. From these portions of the specification, it is clear that the phrase "without installing the rental program on the user computer system" is supported by the specification and is not new matter and the rejection should be withdrawn. The examiner rejection under 35 USC 112, second paragraph should also be withdrawn.

PRIOR ART REJECTIONS

In response to the examiner's rejection of claims 1-5, 7-12, 14-17, 19, 21-23, 25-27, 29-30, 32-36, 38-9, 41-7 and 49-51 under 35 USC 103 as being unpatentable over US Patent Application Publication No. 2005/0198239 to Hughes ("Hughes") in view of US Patent No. 6,334,118 to Benson ("Benson"), Applicant respectfully traverses the rejection for at least the following reasons: 1) Hughes is not prior art to the claimed invention (for the reasons set forth below); and 2) even if

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Hughes is prior art, the combination of Hughes and Benson do not disclose each feature of the claims.

Hughes is not prior art

The present application is entitled to an effective filing date of December 31, 1999 based on the prior filed Korean patent application (1999/68380). The certified copy of this Korean patent application has been received by the US Patent and Trademark Office so that the priority claim has been perfected. The Korean application is substantially identical to the PCT application and the present U.S. application and the Korean application supports the claims in the U.S. application. See MPEP 2136.05.

Furthermore, Applicant is submitting a Rule 131 declaration establishing that the claimed invention was conceived prior to December 22, 1999, which predates the earliest effective filing date of Hughes (December 22, 1999.) The attached declaration establishes that the inventors filed a Korean Patent Application (1999/3481) in February, 1999 (a certified copy of the Korean patent application is attached to the declaration) that contained the key aspects of the claimed invention and constructively reduced the invention to practice as evidenced by the February 1999 Korean patent application so that the invention was conceived and reduced to practice prior to December 22, 1999. Therefore, pursuant to 37 CFR 1.131, Applicant respectfully submits that Hughes is not prior art to the present application. Thus, if Hughes is not prior art to the present application, the obviousness rejection based on the combination of Hughes and Benson should be withdrawn.

The Combination of Hughes and Benson Do Not Disclose Each Feature of the Claims

Even if the examiner disagrees with Applicant's argument that Hughes is not prior art to the claimed invention, the combination of Hughes and Benson still do not disclose each feature of the claims. In particular, the examiner relies on Benson (Col. 5, lines 4-14) to disclose "a system wherein the process manager flushes the main executable file and the optional files of the rental software program from the user computer system so that the rental software program is removed from the user computer system when the rental is completed." However, Benson does not disclose this feature. Benson recites "A customer may, however, delete all copies of the software at the conclusion of the rental period so an alternate approach is provided. Namely, the software is locked

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so that the customer cannot execute the software without first providing an appropriate key. At the end of the rental period, the customer is prohibited from subsequently using this key or any copy of the key. Therefore, at the conclusion of the rental period, the customer can no longer use the software because the customer will no longer be able to provide an appropriate key" at Col. 5, lines 4-14. Thus, Benson discloses that a customer (in order to avoid the rental fee) might delete all copies of the software and that Benson uses a key to lock the software and avoid the problem of a user deleting the software to avoid the rental fee. Thus, Benson does not disclose a system that flushes the main executable file and the optional files of the rental software program from the user computer system and in fact teaches away from flushing the main executable file and the optional files of the rental software program from the user computer system. Therefore, the combination of Hughes and Benson does not render the present claims obvious and the rejection should be withdrawn (even if the examiner continues to assert that Hughes is prior art to the present application.)

Respectfully submitted,

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